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OFFICE OF PETITIONS

In re Application of
Chang & Viswanathan
Application No.: 10/823,513
Filed: April 12, 2004
Attorney Docket No.: 1282-023/MMM
For: AUTORUN FOR INTEGRATED CIRCUIT
MEMORY COMPONENT

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed December 30, 2004 (certificate of mailing date December 27, 2004).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on April 12, 2004 without an executed oath or declaration. On June 25, 2004, a Notice to File Missing Parts of Nonprovisional Application was mailed. This Notice required petitioner to file an executed declaration, filing fees, and a surcharge for their late filing within two months of the June 25, 2004 mail date of the Notice.

In response, on December 30, 2004 (certificate of mailing date December 27, 2004), petitioner filed a four month extension of time request and required fee, filing fees, the surcharge, the instant petition and required petition fee. A statement of facts of William Ho Chang, a co-inventor, accompanies the petition. Mr. Chang states that attempts to contact nonsigning inventor Vinaynathan Viswanathan via telephone and e-mail were fruitless.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$200 as specified in 37 CFR § 1.17(g), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (1) above.

As to item (1), Applicant has failed to establish that Mr. Viswanathan cannot be located.

A showing of **diligence** is critical in obtaining Rule 47 status when an inventor cannot be located or reached.

Petitioner should engage in further efforts to locate Mr. Viswanathan. Possible sources of documentary evidence are inquiries of local telephone directory, inquiries of any extant national or regional registries, telegrams, and searches of Internet databases. Every listed type of search need not be done. However, a diligent effort to find the inventor must be made.

An affidavit or declaration of facts that fully describes the exact facts which are relied upon to establish that a diligent effort was made to locate the nonsigning inventor must be presented. The affidavit or declaration of facts must be signed by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Documentary evidence that supports a finding that the non-signing inventor could not be found or reached should be made part of any affidavits or declarations that fully describe the exact facts which are relied on to establish that a diligent effort was made to locate the non-signing inventor. Printed computer records would suffice.

Petitioner's deposit account was charged an additional \$65.00 because the late declaration/filing fee surcharge was not paid.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By FAX: (703) 872-9306 – ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3230.



E. Shirene Willis
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Office of Petitions